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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,380	08/23/2000	Floyd H. Chilton		1698

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EXAMINER	
JIANG, SHAOJIA A	
ART UNIT	**PAPER NUMBER**
1617	9

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/644,380	Applicant(s) CHILTON, FLOYD H.	
	Examiner Shaojia A. Jiang	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2001 and 11 February 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46 and 49-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's preliminary amendment (amending the specification herein) and response to the Restriction Requirement in Paper No. 6 and 8, submitted October 3, 2001 and February 11, 2002, is acknowledged. Currently, claims 1-51 are pending in this application.

Election/Restrictions

Applicant's election **without** traverse of the invention of Group I, claims 1-46 and 49-51, in Paper No. 6 submitted October 3, 2001, and the invention of the species of γ–linolenic acid and eicosapentaenic acid as the Δ^5 desaturase inhibitor in Paper No. 8 submitted February 11, 2002 is acknowledged.

Claims 47-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The claims have been examined insofar as they read on the elected specie.

Claim Objection

Claim 26 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is well settled that

recitation of an inherent property of a composition will not further limit claims drawn to a composition or method. In the instant case, for example, "isolated from a transgenic cell to produce said at least one unsaturated fatty acid" in claim 26 is an inherent property of the composition herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 29, and 40-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression "further defined as comprising" in claims 8 and 29 renders claims 8 and 29 indefinite. The expression "further defined as comprising" is unclear as to the composition encompassed thereby.

Claims 40-44 contain the trademark/trade name GLA, DGLA, SA, and EPA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods

themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe particular active compounds herein and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 16-17, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by DeMichele et al. (5,223,285, PTO-1449 submitted July 9, 2001).

DeMichele et al. discloses a composition or a liquid nutritional product comprising γ–linolenic acid, eicosapentaenic acid, stearidonic acid, and an antioxidant such as beta-carotene, vitamin E, vitamin C, selenium, and taurine. See abstract and claims 1-23. Thus, DeMichele et al. anticipates claims 1, 3, 5, 16-17, and 19-22.

Applicant is further requested to note that it is well settled that "intended use" of a composition or product, e.g., for diminishing symptoms of inflammatory diorders, will not further limit claims drawn to a composition or product. See, e.g., In re Hack 114, USPQ 161, and *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 4, 6-15, 18, 23-46, and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMichele et al. (5,223,285, PTO-1449 submitted July 9, 2001).

DeMichele et al. discloses a composition or a liquid nutritional product comprising γ–linolenic acid, eicosapentaenic acid, stearidonic acid and other unsaturated fatty acids, and an antioxidant such as beta-carotene, vitamin E, vitamin C, selenium, and taurine. See abstract and claims 1-23.

DeMichele et al. does not expressly disclose the optional employment of around 80-95% pure unsaturated fatty acids in the composition or the nutritional product therein. DeMichele et al. does not expressly disclose the composition further comprising water or corn syrup, and a flavoring agent, an emulsifying agent, a fruit or milk based liquid, a powder; and that the composition herein is stored in the essentially oxygen free air-tight container herein such as a can or a foil pouch.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optionally employ of around 80-95% pure unsaturated fatty acids in the composition or the nutritional product of DeMichele, and to further comprise water or corn syrup, and a flavoring agent, an emulsifying agent, a fruit or milk based liquid, a

powder in the composition or the nutritional product of DeMichele, and to employ an essentially oxygen free air-tight container herein such as a can or a foil pouch to contain the composition or the nutritional product of DeMichele.

One having ordinary skill in the art at the time the invention was made would have been motivated to optionally employ of around unsaturated fatty acids in the composition or the nutritional product of DeMichele since unsaturated fatty acids herein which may be 80-95% pure are well known to be useful in a composition and a nutritional product. Additionally, one of ordinary skill in the art would have been motivated to further comprise water or corn syrup, and a flavoring agent, an emulsifying agent, a fruit or milk based liquid, a powder in the composition or the nutritional product of DeMichele, and to employ an essentially oxygen free air-tight container herein such as a can or a foil pouch to contain the composition or the nutritional product of DeMichele because water or corn syrup, and a flavoring agent, an emulsifying agent, a fruit or milk based liquid, and a powder are well known to be useful in food and nutrition products; the employment of these agents in a composition or a nutritional product and packaging a composition or a nutritional product in an essentially oxygen free air-tight container herein are considered well within conventional skills in food and nutritional science or industry, involving merely routine skill in the art.

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. A. Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.
Patent Examiner, AU 1617
April 4, 2002

MINNA MOEZIE, J.D.
SUPERVISORY PATENT EXAMINER
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